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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,894	03/15/2001	Kazuhiro Yamaguchi	450100-03068	5274

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,894

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 1, and 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, and 21-29 are directed to a "broadcasting receiver." However, the essential structural cooperative relationships between elements in the claims have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skarda et al.

Skarda et al. discloses a broadcasting receiver having a standby state and a normal state of power supply, comprising: an antenna device (antenna in Skarda et al.) for receiving broadcast signals having a frequency associated therewith (as in any satellite antenna, the antenna of Skarda et al., connected directly to the GPS receiver through hardware connectors, is an external antenna for receiving broadcast signals

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having a frequency associated therewith); a slot (PCMCIA GPS Card slot for receiving a peripheral device such as a GPS having an antenna, for example) for inserting a storage medium on which subscription information for receiving a broadcast is recorded (any commercial GPS always includes a storage medium on which subscription info for receiving a GPS broadcast is recorded); a sub-unit including a number of circuits for processing the signals and subscription information (it is inherent that the GPS receiver of Skadar et al. must including signal processing circuits for processing the received signals and subscription information); a detecting means (sensing means in Skarda et al.) for detecting presence or absence of said storage medium inserted in said slot; and a control means (power conversion means in Skarda et al.) for controlling power supply to the GPS receiver having an external antenna connected thereto, and to the number of circuits of the sub-unit; wherein when the broadcasting receiver is in the standby state and the power conversion means of Skarda et al. does not detect insertion of the storage medium, the power conversion means stops power supply to the GPS receiver having the external antenna connected, and resumes power supply to the GPS receiver having the external antenna connected thereto, and to the number of circuits of the sub-unit when the broadcasting receiver is in the normal state and the detecting means (sensing means in Skarda et al.) detects insertion of the storage medium. With regard to claims 25 and 26, it is clear that the user info and subscription are supplied when the GPS is inserted into the slot provided by the PCMCIA, and are processed by a user information processing circuit for processing the subscription information so that the user can view a content or program.

Skadar et al. does not disclose whether the external GPS antenna is a passive antenna or an active antenna comprising a converter circuit. It is well-known that there are only two types of GPS antenna, namely passive antenna and active antenna. The passive antenna does not require power to operate whereas the active antenna requires power of about 5V from the GPS receiver to power the converter/amplifier circuits, and is usually used as external antenna. For more information on the passive and active antennas, a Google search on the subject may be helpful.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select an active type for the external antenna of Skadar et al. for the purpose of providing better, satisfactory, and more reliable signal reception to the GPS receiver of Skadar et al., since the Examiner takes Official Notice that both passive and active GPS antennas are old and well-known in the art, and particularly active antenna is widely known for its use as an external antenna; and selecting an active antenna for the purpose of providing the GPS receiver of Skadar et al. with better, satisfactory, and more reliable signal reception only involves routine skill in the art. Note that when an active antenna is selected for Skadar et al., it is clear that the active antenna of Skadar et al., as any conventional GPS active antenna, requires power to operate and the power conversion means of Skadar et al. must supply power the antenna through the GPS receiver, since the antenna is directly coupled to the antenna terminal of the GPS receiver through hardware connector (see Skadar et al.) to receive power from the Skadar et al. GPA receiver. It is also clear that the power controller of Skadar et al. stops power supply to the GPS receiver and in effect, to the antenna and

to the number of circuits of the sub-unit, since the active antenna of Skadar et al. is directly connected to the GPS receiver through hardware connectors; and resumes power supply to the GPS receiver and in effect, to the antenna and to the number of circuits of the sub-unit when the broadcasting receiver is in the normal state and the detecting means (sensing means in Skarda et al.) detects insertion of the storage medium. With regard to claims 27 and 28, it is inherent that the selected GPS external active antenna of Skadar et al. comprises a low noise frequency converter and amplifier, since all GPS active antennas, by design, must include a low noise frequency converter and amplifier. Again, for more information on the passive and active antennas, a Google search on the subject may be helpful. If Applicants still choose to properly challenge the fact that there are only two types of GPS antenna, namely passive and active antenna, and that passive and active antenna are old and well-known, supportive document(s) will be provided upon request.

### ***Response to Arguments***

Applicants' arguments filed 11/17/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs*

*Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

**The 35 USC 112, 2<sup>nd</sup> paragraph Rejection:**

The amended claim 1 and newly presented claims 21-29 do not overcome the rejection. The basis of the rejection of original claims 1-20 under 35 USC 112, 2<sup>nd</sup> paragraph was clearly set forth in the previous Office Action. In addition, MPEP 2172.01 was cited for support of the rejection. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)." It is clear that various recited elements cited in new claims 21-29 function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes.

**The Skadar et al. 102(b) Rejection:**

With regard to claims 1 (with claims 21-29 stand or fall together), Applicants argued that Skadar et al. does not disclose a “control means for controlling power supply to said antenna device” and “said control means stops power supply to the antenna device and to the number of circuits of said sub-unit.” Applicants’ argument is moot in view of the new ground of rejection. As pointed out above, it is clear that the active antenna of Skadar et al., as any conventional GPS active antenna, by design, requires power to operate; and the “control means” or power conversion means of Skadar et al. must supply power the antenna through the GPS receiver. Without power, the GPS active antenna of Skadar simply will not be able to operate. It is also clear that when the broadcasting receiver of Skadar et al. is in a standby state and the power conversion means of Skarda et al. does not detect insertion of the storage medium, the power conversion means stops power supply to the GPS receiver and in effect, to the antenna, since the active antenna of Skadar et al. is directly connected to the GPS receiver through hardware connectors to receive power from the GPS receiver, and to the number of circuits of the sub-unit.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang  
Primary Examiner